Remarks

In the present application, claims 1-4, 7-22 and 25-28 are pending. Claims 1-4, 7-22 and 25-28 are rejected.

Amendment to the Claims

Claims 1, 4, 7-9, 11-16, 18-19, 22 and 25-27 are amended with merely clarifying amendments. Support for these clarifying amendments may be found throughout the specification, for example, paragraph [0027] ("The strictness may be an arbitrary metric assigned to a collection of privacy attributes such that higher levels of strictness are assigned values that are higher than lower levels of strictness").

Claims 29-30 are newly added. Support for these claims may be found throughout the specification, for example, Figure 2a.

No new matter is added.

Claim Objections

Claims 1, 11-13, 18 and 19 are objected to because of informalities. The Applicants assert that the claims, as presently presented, overcome these objections and respectfully request the Examiner withdraw these objections.

Claim Rejections - 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-4, 7, 9, 11-14, 16, 18-22, 25 and 27 under 35 U.S.C. § 102(e) as anticipated by Koike (U.S. Patent Application No. 2003/0084300), herein Koike (incorporating Cranor et al. "The Platform for Privacy Preferences 1.0 Specification", herein Cranor); and claims 1-4, 7, 11-14, 18-22 and 25 under 35 U.S.C. § 102(e) as anticipated by Bohrer et al. (U.S. Patent Application No. 2003/0088520), herein Bohrer. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-4, 7, 9, 11-14, 16, 18-22, 25 and 27.

These rejections are respectfully disagreed with, and are traversed below.

The Examiner is respectfully reminded that for a rejection to be made under 35 U.S.C. 102(e), it is well recognized that "to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art", *Ex Parte Gould*, BPAI, 6 USPQ 2d, 1680, 1682 (1987), citing with approval *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978).

Regarding claim 1, which recites in part:

A method, comprising:
receiving at a broker a usage policy for constraints related to data of a user in a communication system, wherein said usage policy defines a strictness level value associated with the usage policy, where a strictness level value is a value **assigned to a <u>collection</u> of privacy attributes**;
receiving a request for data associated with the user from a service provider in the communication system to the broker, wherein the service provider possesses a privacy policy and wherein said request comprises a strictness level value associated with the privacy policy of the service provider;
checking, in the broker, the request against a usage policy of the user by **comparing the strictness level value** associated with the usage policy **to the strictness level value** in the received request and associated with the privacy policy of the service provider; and
sending a response to the service provider indicating whether the data can be released, based on the comparison of the strictness level values" (emphasis added).

Neither Koike nor Bohrer are suggested as teaching "a strictness level value is a value assigned to a <u>collection</u> of privacy attributes" or a "comparison of the **strictness level values**" as in claim 1. Rather, Koike and Bohrer are suggested as teaching individual attributes. Therefore, neither Koike nor Bohrer disclose or suggest all elements of claim 1. Thus, claim 1 is not anticipated by either Koike or Bohrer. For at least this reason, claim 1 is in condition for allowance.

As claims 11-13 and 18-19 recite similar language to that discussed above with reference to claim 1, claims 11-13 and 18-19 are likewise in condition for allowance. As claims 2-4, 7, 9, 14, 16, 20-22, 25 and 27 depend upon claims 1, 13 and 19, they are likewise in condition for allowance.

The Examiner is respectfully requested to reconsider and remove the rejection under 35 U.S.C. 102(e) based on Koike; to reconsider and remove the rejection under 35 U.S.C. 102(e) based on Bohrer, and to allow claims 1-4, 7, 9, 11-14, 16, 18-22, 25 and 27.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 8, 15 and 26 as being unpatentable under 35 U.S.C. 103(a) over Bohrer; claims 9, 16 and 27 as being unpatentable under 35 U.S.C. 103(a) over Bohrer in view of Koike; claims 10, 17 and 28 as being unpatentable under 35 U.S.C. 103(a) over Koike in view of Holtmanns et al. (U.S. Patent Application No. 2005/0086061), herein Holtmanns; and claims 10, 17 and 28 as being unpatentable under 35 U.S.C. 103(a) over Bohrer in view of Holtmanns. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 8-10, 15-17 and 26-28.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made[1].

As seen above, neither Bohrer nor Koike disclose or suggest claims 1, 11-13 and 18-19. As claims 1, 11-13 and 18-19 are allowable over both Bohrer and Koike then all claims that depend from claims 1, 11-13 and 18-19 should also be allowable over both Bohrer and Koike, whether considered alone or in combination with other art cited as applied by the Examiner. Further, the addition of the disclosure of Holtmanns to either Bohrer and Koike (without

---

[1] *In Re Fine, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); In Re Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); Agmen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); In Re Sang Su Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).*

admitting that such combinations are suggested or technically feasible) or the combination of Bohrer and Koike (without admitting that such combination is suggested or technically feasible), would not cure the deficiencies in the disclosure of both Bohrer and Koike. For at least this reason, claims 8-10, 15-17 and 26-28 are in condition for allowance.

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 8-10, 15-17 and 26-28.
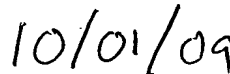
As newly added claims 29-30 depend upon claim 1, they are likewise in condition for allowance for at least this reason.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

Respectfully submitted:

10/01/09
Date

Ricardo Ochoa
Reg. No.: 61,545
Customer No.: 29,683
HARRINGTON & SMITH, PC
4 Research Drive
Shelton, CT 06484-6212

Telephone:(203) 925-9400
Facsimile: (203) 944-0245
Email: ROchoa@HSpatent.com

S.N.: 10/648,644
Art Unit: 2432

800.0148.U1 (US)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Elaine F. Mian   _10/1/2009_
Name of Person Making Deposit   Date

14